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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,123	03/27/2001	Katsuki Hazama	1737/00014	1669

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EXAMINER	
MOSSER, ROBERT E	
ART UNIT	**PAPER NUMBER**
3713	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/817,123	HAZAMA, KATSUKI	
	Examiner	Art Unit	
	Robert Mosser	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,6-15,39 and 40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,6-15,39 and 40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

♦

In response to the amendment filed May 31st, 2005.

This action is Final.

Claims 1, 6-15, and 39-40 are pending.

♦

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 6, 7, 10, 11, 15,** and **39-40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa (US 5,853,327) in view of Zalewski (US 5,991,693) in further view of Hikawa et al (US 5,526,306).

Claims 1, 6, 7, 10, 11: Gilboa teaches a computerized game including a game board (Elm 8) including a first control device for transmitting and receiving data required in terms of advancement in a game, a plurality of game pieces (Elm 10) each including data carrier having control means for transmitting and driving electric power (Col 11:22-32) and the transferring data between the game pieces and the body (Col 12:4-11) where the coil resonance system described provides the power to activate the game piece's transmission means through a query and the data transferred consists of the unique identification broadcast in reply to the body by the piece serves as the transferring of data as so claimed. This feature is interpreted as implicitly providing the "means for notifying the first control device the received driving power has reached a predetermined quantity of electrical power" where in the reply is transmitted by the game piece and received by the control device resultant of "received driving power has reached a predetermined quantity of electrical power" in the coil game piece as so claimed.

Arguments presented below under the section titled "Response to Arguments" are incorporated herein.

Gilboa however is silent regarding the inclusion of a control unit with associated memory in his game pieces for the execution of processes/programs or the storage of the identifier in this memory.

In an analogous patent Zalewski teaches the inclusion of a control unit and associated memory (Col 11:10-54) with game pieces (bodies) for the execution of programs/processes (Col 12:3-27) along with the use of an identification or control

signal (Col 11:55-61) but is silent regarding the use of a coil resonance system or the locating of the game pieces on a game body. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the control unit with associated memory of Zalewski with the board game of Gilboa in order to allow the game pieces to independently determine their position through triangulation (and thereby add a 3rd dimension for position determination), run programs or processes external to the device or alternatively to allow the individual identification of each piece to be readily changed.

Alternatively it would have been obvious to one of ordinary skill in the art at the at the time of invention to have incorporated the coil resonance system of Gilboa as taught above with the control unit and associated memory Zalewski in order to provide a power means which would not require replacement.

The invention of Gilboa and Zalewski however is silent on whether binary or multi-state memory (wherein multi-state is understood to encompass at least 3 states) is used with their game pieces. However Hikawa et al teaches the use of multi-state memory in a method for memory device fabrication (Col 13:47 –54 & Abstract). It would have been obvious to utilize the multi-state memory of Hikawa et al in the game of Gilboa/Zalewski in order to conserve space and/or increase the amount of storage memory available to each piece (See Hikawa Abstract).

Claim 15: In addition to the above stated, the detection and response to the determination of the positional relationship as claimed is shown in figure 4-6 of Zalewski

Claims 39-40: In addition to the above stated Gilboa teaches the inclusion of a coil resonance system incorporating an excitation signal transmission followed by a cessation of signal transmission (Figure 3). For further clarification GB 2103943 incorporated by reference Gilboa (Col 11:25-27) teaches emitting a first pulse then on the receipt or lack of receipt of notification that the received driving electrical power has reached a predetermined quantity of electrical power interrupting the transmission of radio wave signal for a predetermined period of time (*GB 2103943* Fig 3).

Claims **8, 9,** and **12-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa (US 5,853,327) in view of Zalewski (US 5,991,693) in further view of Hikawa et al (US 5,526,306) and yet further in view of Bergeron (US 4,764,666).

The invention of Gilboa/Zalewski/Hikawa or Zalewski/Gilboa/Hikawa is silent regarding the use of contact terminals and the storing of information identifying information.

Bergeron teaches in an on-line wagering system with programmable game entry cards that teaches the use of a contact terminal for transmitting and receiving via touch (Col 13:39-49) or electromagnetic waves (13:45-49) and the inclusion of player identifying information on the device including bank account numbers (3:25-38) as well as other player specific information for identifying the individual (7:45-55).

It would have been obvious to one of ordinary skill at the time of invention to have incorporated the invention of Bergeron with the invention of

Gilboa/Zalewski/Hikawa or Zalewski/Gilboa/Hikawa as disclosed above in order to provide a system with increased security from fraudulent use, reduce electromagnetic interference generated through the contact terminals, or provide a method to locate the owner of lost game pieces.

Regarding at least claim **14** as best understood, the invention of Gilboa/Zalewski/Hikawa or Zalewski/Gilboa/Hikawa includes the ability to store information in a multi-value memory regarding the object moving said object. Wherein the "object" as presented is interpreted as a person.

Response to Arguments

Applicant's arguments filed May 31st, 2004 have been fully considered but they are not persuasive. Applicant argues that the inclusion of the prior office action failed to establish a prima facie case of obviousness for deficient evidence of implicit or inherent features. The applicant's argument directed to this aspect fail for at least three reasons.

I) The applicant interchanges the use of "inherent" and implicit in their response and further incorporates arguments and citation, which are directed to "inherency" and not "implicitly". The courts have long distinguished between concepts likewise arguments interchanging or equating two constructs are improper.

II) The applicant's present claim language as present in claims 1 and 6 incorporate "means plus function " type language therefore incorporate any equivalent structure capable of performing the claimed functionality until such time as the applicant were to so limit the interpretation of their claim language through invoking USC 112 6th paragraph.

III) The applicant has provided no evidence or reference to the disclosure of Gilboa their would support their interpretation that previously presented implicit feature of Gilboa and the examiner's assertions related thereto are deficient beyond mere allegation.

Finally as Gilboa sets forth a circuit powered only by the transmission of an outside signal (Col 16:11-32) and to transmit a signal in response to the original signal (Figure 3) they have indeed transmitted a signal in response to achieving enough power to do so (Figure 3). In view of the facts presented above and the rejection originally presented the rejection as previously presented is maintained. Further references to the resonance type system however may be seen in GB 213943 A1 incorporated through reference in Gilboa (Col 11:25-27).

Remaining argument fall for their reliance on the above mentions applicant assertion.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

XUAN M. THAI
SUPERVISORY PATENT EXAMINER
TC3700